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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,964	11/03/2000	Mir Hajmiragha	ASTS-1-1004	5052

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EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,964

Applicant(s)

HAJMIRAGHA ET AL.

Examiner

Zachary A. Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
*Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20050429.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A Request for Continued Examination with amendment was received on 05 May 2005. By this amendment, Claims 1, 2, and 7 have been canceled, Claims 3-5 have been amended, and new Claims 8-15 have been added.
2. A supplemental response was received on 09 May 2005. The supplemental amendment has not been entered *as a matter of right*, because the response was not filed within a period during which action by the Office was suspended under 37 CFR 1.103(a) or (c). See 37 CFR 1.111(a)(2)(ii). However, at the Examiner's discretion and in the interest of advancing the prosecution of the present application, the supplemental response has been entered and considered. By the supplemental amendment, Claims 8-15 have been canceled and new Claims 16-25 have been added. Claims 3-6 and 16-25 are currently pending in the present application.

Response to Arguments

3. Applicant's arguments filed 05 May 2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically, Applicant argues that Brown et al, US Patent 6671805, does not teach or suggest selecting from a list consisting of an acceptance option and a decline option for one or more blocks of unedited text. First, the Examiner notes that the previous Office action noted that Brown does not explicitly disclose a decline option, and that the Padawer reference was relied upon to teach such a limitation. Second, the Examiner notes that the specification of the present application does not provide proper antecedent basis for the limitation of blocks of unedited text, and is silent on the point of editing text. Finally, the Examiner believes that Brown does not *require* editing or modifying the to-be-signed portions of a document. Brown states that a “browser is used to display *and/or* edit” the document (column 13, lines 19-21, emphasis added); it is noted that editing of the document is disclosed in the alternative, and is therefore not a required function. The Examiner further notes that Brown discloses that access for altering at least portions of a document can be prevented (see column 12, line 56-column 13, line 7).

Further, Applicant's arguments regarding Padawer et al, US Patent 5220675, are moot in view of the new grounds of rejection.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the newly added limitations of Claims 3 and 5 regarding "blocks of unedited text". See below regarding the rejections under 35 U.S.C. 112, first paragraph.

Claim Objections

5. Claim 3 is objected to because of the following informalities: The claim recites the limitation "the uniquely identifying blocks" in line 10 of the claim. It appears that this is intended to read "the uniquely identified blocks". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, Claims 3 and 5 have been amended to recite the limitation "blocks of unedited text" throughout the claims. There is no mention in the specification as to whether the text is, in fact, "unedited", nor is there any mention of editing text whatsoever. Claims 4 and 6 are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 16-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al, US Patent 6671805.

In reference to Claim 16, Brown discloses a method for signing documents including registering an electronic document in a document repository computer-based system (column 7, lines 36-49), displaying the registered document at one of a plurality of remotely located computer-based systems (column 13, lines 13-14), recording at the repository system a designation of one or more areas of the registered document for

signature tasks (column 8, lines 35-37), recording at the repository system an assignment of one or more registered users of the document repository system to one or more of the designated areas of the registered document (column 8, lines 5-7), presenting the assigned areas of the document for review to the registered user (column 13, lines 13-19), recording a selection of an acceptance option for each of the assigned areas (column 13, lines 22-27), and executing an electronic signature of the assigned areas (column 13, lines 22-24; column 13, line 52-column 14, line 10).

In reference to Claim 17, Brown further discloses uniquely identifying the document (column 7, lines 39-53), uniquely designating the areas assigned for signature tasks (column 8, lines 35-37), associating users with the designated areas (column 8, lines 5-7), and verifying the correctness of the document and designated areas (column 22, lines 12-22).

In reference to Claim 18, Brown further discloses storing information about the assigned user and electronic signature credentials of the user (column 10, line 58-column 11, line 16).

In reference to Claim 19, Brown further discloses allowing retrieval of registered documents with previously assigned and executed signatures (column 22, lines 9-22).

In reference to Claim 20, Brown further discloses assigning a deadline for the completion of assigned actions (column 19, line 61-column 20, line 5, where the signer is notified if the signing has not been completed by a certain time).

Claims 21-25 are directed to systems that correspond substantially to the methods of Claims 16-20, and are rejected by a similar rationale.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Bisbee et al, US Patent 6367013.

In reference to Claim 3, Brown discloses a method for signing documents by users at a plurality of remotely located computer-based systems (Figure 5, elements 502; column 14, line 65-column 15, line 4) coupled to a document computer-based system (Figure 5, element 506; column 17, lines 16-18), where the method includes displaying an electronic document at one of the plurality of remotely located systems (column 9, lines 43-45); identifying blocks of text for at least one signature task (column 8, lines 35-37); uniquely identifying blocks of text (column 8, lines 35-37); allowing for review of the uniquely identified blocks of text (column 13, lines 13-19) that are assigned to one or more users (column 8, lines 5-7); selecting an acceptance option (column 13, lines 22-27); digitally signing the document (column 13, lines 22-24); registering documents at the document computer-based system component by

identifying blocks of text (column 11, lines 65-67) and verifying the correctness of blocks of text (column 22, lines 12-22); storing information of the users, digital signatures, and users' selections (column 9, lines 24-26 and 37-42); and allowing retrieval of documents with signature tasks, stored digital signatures, and selections of acceptance options (column 10, lines 1-5; column 18, lines 59-63). However, although Brown discloses selecting an acceptance option and that this may be performed in a number of ways (column 13, lines 22-27), Brown does not explicitly disclose selecting a decline option.

Bisbee discloses a method and system including electronic documents which can be an authenticated offer from one entity to a second entity, and that the second entity can indicate acceptance of the electronic document offer or counter-offer (that is, decline the first offer; see column 23, lines 23-35). Bisbee further discloses that once the second entity indicates acceptance or decline, a digital signature is executed over the first offer document and the second entity's response (see column 24, lines 29-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Brown by including selection of an acceptance or decline option, in order to provide security and protection of electronic documents (see Bisbee, column 1, lines 33-39) and to give the signed electronic document the same legal weight as a signed physical document (see Bisbee, column 3, lines 29-36).

In reference to Claim 4, Brown further discloses assigning a completion deadline (column 19, line 61-column 20, line 5, where the signer is notified if the signing has not been completed by a certain time).

In reference to Claim 5, Brown discloses a document signing system including a user interface component for displaying an electronic document (column 9, lines 43-45) and identifying blocks of text for at least one signature task (column 8, lines 35-37); a processing component for uniquely identifying blocks of text (column 8, lines 35-37); and a browser component including an assigning component for assigning users to uniquely identified blocks of text (column 8, lines 5-7), a signing component for reviewing the assigned blocks of text (column 13, lines 13-19) and digitally signing the document (column 13, lines 22-24) and selecting and storing an acceptance option (column 13, lines 22-27). However, although Brown discloses that selecting the acceptance option may be performed in a number of ways (column 13, lines 22-27), Brown does not explicitly disclose selecting a decline option.

Bisbee discloses a method and system including electronic documents which can be an authenticated offer from one entity to a second entity, and that the second entity can indicate acceptance of the electronic document offer or counter-offer (that is, decline the first offer; see column 23, lines 23-35). Bisbee further discloses that once the second entity indicates acceptance or decline, a digital signature is executed over the first offer document and the second entity's response (see column 24, lines 29-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Brown by including selection of an acceptance or decline option, in order to provide security and protection of electronic documents (see Bisbee, column 1, lines 33-39) and to give the signed electronic

document the same legal weight as a signed physical document (see Bisbee, column 3, lines 29-36).

In reference to Claim 6, Brown further discloses assigning a completion deadline (column 19, line 61-column 20, line 5, where the signer is notified if the signing has not been completed by a certain time).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

zad


MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137